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08/855,061 05/13/97 AUGUSTINE

S 1342-196

EXAMINER

QM12/0522

TERRANCE A MEADOR
GRAY CARY WARE & FREIDENRICH
401 B STREET SUITE 1700
SAN DIEGO CA 92101

GRAHAM, M

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 39

Application Number: 08/855,061

Filing Date: 05/13/97

Appellant(s): Augustine et al.

Terrance A. Meador
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 3/2/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. It should be noted that application number 08/846,089 by the same inventors which pertains to subject matter common to this application has previously been appealed.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 20, 22, 34; 21; 23, 28, 31; 25-27, 29, 30; 32,33; 35,36; and 37-39 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

3714947	Hardy	2-1973
4,572,188	Augustine et al.	2-1986
2,110,022	Kliesrath	3-1938
113,420	Roehr	7-1984

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 20, 21, 22, and 34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Roehr. This rejection is set forth in prior Office action, Paper No. 4. Further attention is directed to Fig. 2 of Roehr which shows the blanket with its base sheet and overlaying material sheets 11, 111 and apertures 25. Regarding the "laminate" limitation note the Roehr translation at page 4, penultimate paragraph where Roehr states that the sheets may comprise fabric lined with foil which the examiner considers a laminated material. The sheets are connected peripherally at 15 and within the periphery at 41,42.

Claims 23, 25, 26, 27, 28, 29, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roehr. This rejection is set forth in prior Office action, Paper No. 4.

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Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Augustine '188 in view of Roehr. This rejection is set forth in prior Office action, Paper No. 4.

Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roehr in view of Hardy. This rejection is set forth in prior Office action, Paper No. 4.

Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Augustine in view of Roehr and Hardy. This rejection is set forth in prior Office action, Paper No. 4.

(11) *Response to Argument*

Regarding claims 20, 22, and 34, appellants first argue that Roehr does not disclose a "laminate" structure. Appellants offer that Roehr does not actually use the German word for "laminate" in describing his device. Thus, appellants argue that although each and every structural feature of the claimed device is disclosed by Roehr and the device is used in the same manner, it cannot anticipate appellants' device because the reference does not use the identical terminology in describing the device. Clearly 35 U.S.C. 102(b) does not require such from the prior art reference. Appellants' argument is akin to one arguing that because he has claimed a "car" and the prior art shows an "automobile", the prior art cannot be anticipatory. In the examiner's opinion Roehr's description of "a fabric lined with plastic foil" meets the claimed "laminate" material limitation. This is the meaning one of ordinary skill in the art would take from such a description.

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Appellant's further arguments regarding the "laminate" limitation are not persuasive. Appellant argues that a laminate base sheet with an underlayer of fibrous material and an upper surface is not disclosed. In response it is the examiner's position that Roehr specifically states that layer 11 may comprise a "fabric lined with plastic foil". Thus are two layers - the fabric layer and the foil layer. Roehr's fabric layer may be considered the "under layer" and Roehr's foil layer may be considered the upper surface. Roehr's layer 11 which comprises both of these layers is attached to the overlaying sheet 111.

The Moore reference was cited by the examiner in paper No. 33 in response to appellant's request to provide evidence to support the conclusions of inherency based on the meaning of "laminate". Moore is another fluid flow medical heat transfer device, and shows a fabric lined with plastic foil, and refers to the structure as a laminated structure. It is for these reasons that Moore is cited. The examiner has not contended that Moore shows apertures for water flow. Moore is from the thermal treatment art and gives an example of "laminate" as the term is used in the art. It should be noted that Moore is merely redundant in this regard as this is the meaning of "laminate" taken in all arts of which the examiner is aware.

In response to appellants' next argument, starting on page 5 of the brief, as can be quite clearly seen in Figure 2 of Roehr, an inflatable space exists between fabric/foil layers 11 and 111. Roehr describes this space as "inter-connected air duct-like sections 25." Into this space air may be pumped by blower 75. As any laymen will appreciate, when air is pumped into Roehr's device with sufficient pressure it will inflate. This is all that the claims require.

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Regarding the openings 25 of Roehr, the examiner does not find them to be “large” and there is no indication that Roehr’s drawing is to scale. Furthermore, it is again pointed out that the claims only require a blanket capable of inflation. Even if it was Roehr’s intention to try the tortuous process of dispersing air without actually “inflating” the blanket this has no bearing on what the blanket is capable of when sufficient pressure is applied to the blanket. As opposed to the indisputable nature of Roehr’s disclosed device, appellants offer that Roehr does not actually use the German word for “inflatable” in describing his device. Thus, appellants argue that although each and every structural feature of the claimed device is disclosed by Roehr and the device is used in the same manner, it cannot anticipate appellants’ device because the reference does not use the identical terminology in describing the device. This is not what 35 U.S.C. 102(b) requires.

Appellant’s argue that foil may mean a stiff material. In response the examiner points out that the term is used in the context of a blanket, a flaccid device, and that the definition of “plastic foil” as commonly used would mean a thin flexible material. To try to give “foil” appellant’s definition strains one’s credulity. Appellant relies on the Wales reference to support his position. However, Wales does not pertain to a “fabric lined with plastic foil” and is clearly not relevant to the issue. Under applicant’s previous reasoning, Wales would be completely irrelevant because it does not use the terminology “fabric lined with plastic foil”. Even under a common-sensical approach, Wales, at most, discloses what steps must be taken to make a bed covering self supporting, as opposed to uninflatable, and Roehr involves none

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of these self-supporting features. Whatever the nature of the “Wales” patent the focus here is on whether Roehr meets the “inflatable” limitation. As pointed out above, this limitation is clearly disclosed.

Concerning the actual structure of Roehr’s inflatable blanket it is again pointed out that layer 11 may comprise a “fabric lined with plastic foil”. Thus, there are two layers - the fabric layer and the foil layer. Roehr’s fabric layer may be considered the “under layer” and Roehr’s foil layer may be considered the upper surface. Roehr’s layer 11 which comprises both of these layers is attached to the overlaying sheet 111 at the periphery, and within the periphery, to form the inflatable blanket

Concerning the claim 21 argument, the appellant does not claim that the opening is aligned with the center axis of the blanket. The claim states that the opening is into the center of the blanket. Roehr’s “center” is considered to include the area to either side of the center axis and thus the opening shown in Roehr (Fig. 1) is “into the center” of the blanket.

Concerning the argument over claims 23, 28, and 31 the examiner took notice in the original office action, paper No. 4, that to substitute paper material for fabric material for purposes of disposability was commonly known. In paper No. 30 applicant’s requested that the examiner provide evidence to back up the assertion of the substitutability of paper for fabric. In response, the examiner cited Moore which teaches the interchangability of woven fibrous (fabric) materials and nonwoven fibrous (paper) materials in such applications. See Moore at Col. 1 first paragraph and Col. 3, lines 14-16. Thus, the examiner has established

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the basis of his rationale and the motivation for the rationale. Appellant is reminded that under MPEP 2144.03 the examiner may cite a reference to back up his position. An affidavit is not required.

Regarding the source of the motivation, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is generally known in the medical art to substitute paper for fabric for purposes of disposability related to efficiency and sanitary requirements. If it is appellants' (who have considerable medical experience) position that paper is not substituted for fabric for bedding and other linens in medical settings, such should be clearly stated on the record.

Regarding claims 25-27, 29, and 30, the examiner has explained the structure of Roehr's blanket above. Regarding the arrangement of the layers, it is the examiner's position that the plain meaning of a "fabric lined plastic foil" is a material with the fabric (a fibrous material) on the outside lined on the inside with plastic foil. This is the everyday meaning given to such a phrase, as with a coat for example. The reference does not disclose a "plastic foil lined with fabric." Moreover, were the fabric on the inside it would have made it very difficult to weld the sheets to one another, as desired by Roehr, as the fabric would be between

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the plastic of layers 11 and 111 which need to be welded to one another. Because appellant also challenged this rationale, the examiner offered Moore as support to show that when one speaks of a lined laminated plastic foil as in Roehr, they mean a laminate structure wherein the fabric lining faces the patient. This is what the fiber layer accomplishes. This is its reason for being in such structures. It would have served no purpose as an interior layer.

Concerning claim 26, the "center" limitation has been previously addressed.

With regard to the appellant's argument of claims 32 and 33, it is appellant's assertion that comfort deriving from a fibrous layer is an unexpected result of the invention and was gleaned from other patents which appellant's disclosure predates. It is the examiner's position that the discovery of fibrous materials (e.g. clothing, linens etc.) for human comfort clearly predated appellant's disclosure and it is on this basis that the examiner cited the notion of comfort as a motivation to supply the Augustine '188 blanket with fibrous materials as disclosed in the Roehr reference. Again motivation to combine may come from the knowledge generally available to one of ordinary skill in the art.

Regarding the argument found at the top of page 10 of the brief, that the Augustine '188 cover is formed from tubes to obtain the base and overlaying sheets of the inflatable structure, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is

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what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With respect to the claim 35 and 36 argument over the Roehr/Hardy combination, Hardy has been cited to show that it is known in the art to provide a recess in the blanket head portion. Such a recess is by definition non-inflatable. It would have been obvious to have provided such a recess in Roehr's blanket as well to accommodate the head. This gives the inherent advantage of better covering the body as a whole while leaving the airways of the person unblocked. It is the examiner's position that this motivation to provide such a non-inflatable recess as disclosed by Hardy is self-evident. Given that it is known in the art to provide fluid flow blankets with a recess at the head end which on its face provides better blanket coverage of the person it would have been obvious to have employed the technique with other fluid flow blankets in the art.

Regarding claims 37-39 Augustine '188 discloses the claimed invention with the exception of the fibrous layer and the non-inflatable portion. As explained above, Roehr teaches the fibrous layer in the art, and Hardy teaches the non-inflatable portion in the art. The motivations to employ both of these features on a blanket such as Augustine '188's have also been thoroughly discussed. Appellant's have offered no arguments not previously addressed by the examiner in this regard. The Diebol declaration cited by appellant does not address claims 37-39 in any fashion and thus is not persuasive on any point previously raised.


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The declaration makes no nexus between the point asserted by appellant's (unexpected results) and the device of claims 37-39.

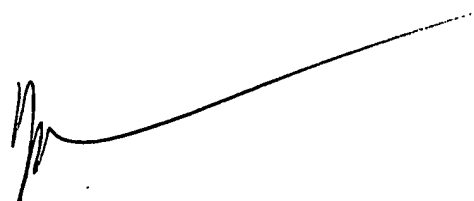
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Appeal Conference Conferees:

Steve Wong 

Raeann Gorden 



Mark S. Graham

May 18, 2001

Mark S. Graham
Primary Examiner